

Remarks

In response to the final office action mailed September 29, 2004, the Applicant respectfully requests reconsideration of the rejections and that the case pass to issue in light of the amendments above and the remarks below.

Claims 1-20 are pending and the Examiner is respectfully requested to enter new claims 21-22. New claims 21-22 include limitations similar to those recited in rejected independent claims 10 and 18 and further limitations directed towards positioning a rod in closed proximity to a door hinge of a safe such that the rod extends therefrom to a surface to which the safe is secured to prevent insertion of a prying device between the door hinge and the surface while also permitting the door to be opened when the anti-prying device is so positioned. The Applicant kindly thanks the Examiner for allowing claims 1-10 and note that new claims 21-22 include limitations similar to those of allowed independent claim 1.

The Examiner has set for the following rejections in the office action: (1) claims 10-12 and 15-20 are rejected under 35 U.S.C. §103(a) as being obvious over U.S.P.N. 5,845,433 to Walsh (hereinafter the Walsh patent) in view of U.S.P.N. 5,873,273 to Vick (hereinafter the Vick patent); and (2) claims 13 and 14 are rejected under 35 U.S.C. §103(a) as being obvious over the Walsh and Vick patents in view of Official Notice.

Rejection of claims 10-12 and 15-20 Under 35 U.S.C. §103(a)

The Applicants respectfully submit that the Examiner has improperly rejected claims 10-12 and 15-20 under 35 U.S.C. §103(a) as being obvious over the Walsh and Vick patents.

With respect to independent claim 10, the Walsh and Vick patents fail to disclose an anti-prying device to limit wedging and working of a prying element between a

door hinge of a safe and a surface to which the safe is anchored, wherein the anti-prying device includes a member positioned between the door hinge and the surface to restrict insertion of the prying element between the door hinge and the surface to prevent stealing of the safe by prying up the door hinge to uproot the safe from its anchorings.

In contrast, the Walsh patent discloses an internal bar positioned within an inner cavity of a safe to prevent a door of the safe from being pushed backwardly into an interior of the safe. The Examiner admits that the Walsh patent fails to disclose the Applicant's claimed externally mounted anti-prying device. To make up for this deficiency, the Examiner asserts that it would be obvious to modify the internal bar of the Walsh patent to be an externally mounted item for preventing uprooting of the door hinge in light of the Vick patent disclosing a door stop that extends horizontally along a base of door in a home to prevent the door from being opened.

Initially, the Applicant asserts that there is no motivation to combine the teachings of the Walsh and Vick patents absent improper hindsight derived from the Applicant's application, and as such, it is improper for the Examiner to reject independent claim 10 as being unpatentable over the Walsh and Vick patents. With respect to the motivation necessary to modify the internal bar of the Walsh patent to include the door stop of the Vick patent, MPEP § 2144.01 states the following (emphasis added):

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which

is conformable to a ground surface of varying slope not suggested by combination of prior art references).

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water.

* * *

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested

combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

As stated above, there must be some "objective" reason in the cited references to "suggest" modifying the internal bar of the Walsh patent in light of the door stop of the Vick patent. The Examiner has failed to point out any such objective suggestion because no such suggestion exists. There is no such suggestion because the Walsh and Vick patents, in fact, teach away from such a suggestion. The Walsh patent teaches to internally mounted bars to prevent a safe door from being pushed backwardly into an interior of the safe. The use of an internally mounted bar, as opposed to an externally mounted features, clearly indicates that the Walsh patent teaches away from including such an external features, such as the door stop of the Vick patent. For this reason alone, the Examiner has failed to properly combine the Walsh and Vick patents in setting forth the rejection.

In addition, the foregoing clearly states that it is improper to combine references if doing so renders the Walsh patent unsuitable for its "intended purpose" and/or changes its "principle of operation." The Examiner's rejection fails on both accounts. In particular, the intended purpose of the Walsh patent is to prevent a safe door from being pushed backwardly into an interior of the safe such that modifying it to include the externally mounted bar of the Vick patent would change its intended purpose as it would no longer prevent pushing-in of the safe door. Furthermore, the principle operation of the Walsh safe is to use internally mounted features for preventing the safe door from moving backwardly into the safe such that modifying it to include the externally mounted door stop of the Walsh patent would change its principle of operation as it would no longer operate with an internally mounted bar to prevent pushing-in of the safe door. For this reason alone, the Examiner has failed to properly combine the Walsh and Vick patents in setting forth the rejection.

Notwithstanding the fact that the Examiner's rejection is based upon improper motivation to combine the Walsh and Vick patents, such an improper combination still fails to teach each element recited in independent claim 10. With respect to teaching each element, MPEP § 2144.03 states the following (emphasis added):

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Neither the Walsh or Vick patents disclose an anti-prying device to limit wedging and working of a prying element between a door hinge of a safe and a surface to which the safe is anchored, wherein the anti-prying device includes a member positioned between the door hinge and the surface to restrict insertion of the prying element between the door hinge and the surface to prevent stealing of the safe by prying up the door hinge to uproot the safe from its anchorings.

In particular, the door stop of the Vick patent does not restrict insertion of a prying element between a door hinge of a safe and a surface to which the safe is anchored. As clearly shown in Figure 1 of the Vick patent, the door hinge is completely exposed above the door stop such that it may be easily pried up with a prying element. As such, even the improper combination of the Walsh and Vick patents fail to teach each element recited in independent claim 10.

With respect to independent claim 18, the Walsh and Vick patents fail to disclose providing an anti-prying device having a base and a rod extending from the base and aligning the anti-prying device such that the rod extends between the door hinge and the surface to restrict insertion of the prying element therebetween. As described above, the Walsh and Vick patents only relate to devices that prevent a door from being opened. Neither patent discloses a device that prevents a prying element from being inserted between a door hinge of a safe and a surface to which the safe is secured. Moreover, neither reference

recognizes the problem of aligning a device under the door hinge of a safe to prevent uprooting of the safe by positioning a prying element between the door hinge of the safe and the surface to which the safe is secured. Consequently, neither Walsh or Vick can teach the method step of aligning the anti-prying element to prevent such uprooting as recited in independent claims 18.

With respect to the Examiner's statements that the combined teachings of the Walsh and Vick patents inherently teach the foregoing method step of aligning the anti-prying element, MPEP § 2163.07(a) states the following (emphasis added):

2163.07(a) Inherent Function, Theory, or Advantage

... **"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"** In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As stated above, to be "inherent" the combined teachings of the Walsh and Vick patents must "necessarily" present the step of aligning the anti-prying element relative to the safe door hinge so as to prevent uprooting of the safe door hinge, and not the mere "possibility or probability" of doing so or that doing so "may result" from their combined teachings. The combination of the Walsh and Vick patents fail to meet these criteria as both patents fail to provide any teaching to aligning the anti-prying element in the claimed manner and both patents perform their intended functions without "necessarily" aligning the anti-prying element in the claimed manner.

For the foregoing reasons, the Applicants respectfully submit that the Examiner has relied upon improper motivation to combine the Walsh and Vick patent and that even such an improper combination fails to teach each element recited in independent claims 10 and 18. Consequently, independent claims 10 and 18, and dependent claims 11-12, 16-17, and 19-20,

which depend therefrom and include all the limitations thereof, are patentable and nonobvious over the cited references.

Rejection of claims 13 and 14
Under 35 U.S.C. §103(a)

The Applicants respectfully submit that claims 13 and 14, which depend from patentable independent claim 10, and include all the limitations thereof, are patentable for at least for the same reasons that independent claim 10 is patentable.

Rejection of claims 15 and 17
Under 35 U.S.C. §103(a)

Dependent claims 15 and 17 are rejected in light of the rejections set forth above with respect to independent claim 10. The Examiner has not distinguished the rejection of claims 15 and 17 over the rejections to independent claim 10 from which they depend. However, the Applicants respectfully request that the Examiner do so and have provided this additional section of remarks to address the separate patentability of dependent claims 15 and 17.

Dependent claim 15 depends from independent claim 10 and further includes a rod extending co-axially with the door hinge between the door hinge and the surface. The Walsh and Vick patents fail to teach such a feature. Neither the internal bar of the Walsh patent or the door stop of the Vick patent include a rod extending co-axially between a door hinge and a surface.

Dependent claim 17 depends from dependent claim 15 and further includes the rod being sufficiently dimensioned to cover an area between the safe door and an outer front portion of the door hinge to prevent a prying element from being inserted between the door and the rod. Neither the internal bar of the Walsh patent or the door stop of the Vick patent

disclose dimensioning their respective bars so as that the bars are large enough to cover the underside of a door hinge, and thereby, prevent insertion of a prying element between the door and the rod.

For the foregoing reasons, the Applicant respectfully submits that dependent claims 15 and 17 are separately patentable over the Walsh and Vick patents.

New claims

New claims 21-22 include limitations similar to those recited in rejected independent claims 10 and 18 and further limitations directed towards positioning a rod in closed proximity to a door hinge of a safe such that the rod extends therefrom to a surface to which the safe is secured to prevent insertion of a prying device between the door hinge and the surface while also permitting to door to be opened when the anti-prying device is so positioned.

The Applicant respectfully submits that new claims 21-22 are patentable for at least the same reason that independent claims 10 and 18 are patentable. Moreover, new claims 21-22 are further patentable because they more distinctly claim the positioning of the anti-prying element with respect to the door hinge and that the door may be opened when the anti-prying device is in position. The distinct claiming of the positioning of the anti-prying element with respect to the door hinge tracks the reasons for allowance of independent claim 1 and is thus believed to render new claims 21-22 similarly patentable. Moreover, the further limitations of new claims 21-22, with respect to permitting the door to be opened when the anti-prying device is in position, add further reasons for allowance as the Vick patent, which the Examiner is relying on to teach an externally mounted bar for preventing uprooting of the door hinge and to make up for the deficient teachings of the Walsh patent, prohibits operation of the door when the door stop is in position.

Reply to Final Office Action of September 29, 2004

The Examiner is respectfully requested to enter new claims 21-22 as these claims fail to add new issue and include limitations in addition to the previously allowed claims.

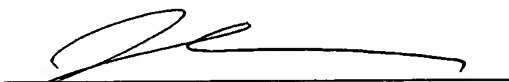
Conclusion

In view of the foregoing, the Applicants respectfully submit that each rejection has been fully replied to and traversed and that the case is in condition to pass to issue. A check in the amount of \$176.00 is enclosed to cover the fees associated with new independent claims 21-22. The Examiner is respectfully requested to pass this case to issue. The Examiner is invited to call the undersigned if it would further prosecution of this case to issue.

Respectfully submitted,

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